

REMARKS/ARGUMENTS

Favorable reconsideration of this application, in view of the present amendment and in light of the following discussion, is respectfully requested.

Claims 1, 4-8, and 10-16 are pending. Claims 4, 6, and 10-13 were previously withdrawn. In the present amendment, Claims 1 and 8 are currently amended and Claims 3 and 9 are canceled without prejudice or disclaimer. Support for the present amendment can be found in the original specification, for example, at page 3, lines 25-29, at page 4, lines 5-7, and in Claims 3 and 9. Thus, it is respectfully submitted that no new matter is added.

In the outstanding Office Action, Claims 1, 3, 5, 7-9, and 14-16 were rejected under 35 U.S.C. § 103(a) as unpatentable over Kobayashi et al. (WO 03/007752, hereinafter "Kobayashi").

Regarding Applicants' claim to foreign priority, for at least the reasons discussed in previous responses, Applicants again respectfully submit that the foreign priority claim to JP 2004-008099 made at the time of filing was proper and Applicants do not waive that claim to priority.

In response to the rejection under 35 U.S.C. § 103(a), Applicants respectfully request reconsideration of this rejection and traverse this rejection, as discussed below.

Amended Claim 1 recites:

A hair holder, comprising:

a flat tube having a sheet which forms a first side and a sheet which forms a second side to allow a hair bundle to be inserted from an opening at one end of the tube toward an opening at an other end thereof such that, when the hair holder is rolled up, the sheet which forms the first side is on an outside of the tube,

the sheet which forms the first side of the tube is more extensible in a length direction of the tube than the sheet which forms the second side of the tube,

the sheet which forms the second side of the tube has a
Taber stiffness of 0.4 mNm or higher, and

the sheet which forms the first side has an extensibility
of at least 15 times an extensibility of the sheet which forms the
second side under a load of 5 N,

the extensibility of the sheet which forms the first side is 10% or
greater under the load of 5 N, and

the extensibility of the sheet which forms the second
side is 5% or less under the load of 5 N.

It is respectfully submitted that the cited reference does not disclose or suggest every
feature recited in Claim 1.

Kobayashi describes a hairdressing tool formed of two rectangular sheets. Kobayashi
describes an embodiment in paragraph [0132] that includes sheet 223A having longitudinal
extensibility and sheet 223B that has substantially no longitudinal extensibility.¹

Accordingly, the two sheets 223A and 223B form a tube 212 of a hair holder 200 having
substantially no extensibility as a whole.² Kobayashi also describes alternative embodiments
and states that, as long as the tube has substantially no extensibility as a whole, part of the
sheet(s) forming the tube may have extensibility.³

The Office Action, in the last paragraph on page 3, again acknowledges that
Kobayashi does not disclose “the first side of the sheet having at least 15 times higher of an
extension under a load of 5N as of the second sheet.” Instead, in the first paragraph on page
4, the Office Action asserts that such a ratio of extensibility between the first and second
sheet would have been obvious to one having ordinary skill in the art at the time of the
invention “since it has been held that where the general conditions of a claim are disclosed in
the prior art, discovering the optimum or workable ranges involves only routine skill in the

¹ See Kobayashi, at paragraph [0132] of U.S. Publication No. 2004/0231689, which is the national stage
application of WO 03/007752.

² See Kobayashi, at paragraph [0132].

³ See Kobayashi, at paragraph [0133].

art. In re Aller, 105 USPQ 233.” Applicants respectfully traverse this position since the claimed extensibility ratio is an unexpected result discovered by the inventors of the present application. See MPEP 2144.05 III.

In support, Applicants submit the attached Declaration. As discussed in the attached Declaration, Example 3 was prepared in accordance with Claim 1. The sheet which forms the first side of the hair holder of Example 3 has an extensibility of at least 15 times an extensibility of the sheet which forms the second side under a load of 5 N. Accordingly, an acceptable curl is provided to the hair in the hair holder.

Comparative Example 3 was also prepared, and corresponds to Claim 1 with the exception of a extensibility. Specifically, the sheet which forms the first side of Comparative Example 3 has an extensibility of 13 times an extensibility of the sheet which forms the second side under a load of 5 N. As shown in the Table in the Declaration, the hair holder of Example 3 has an acceptable curling, whereas the curling from the hair holder of Comparative Example 3 is not acceptable.

In the Response to Arguments section on page 5, the Office Action explains why the previous Declaration was insufficient to show unexpected results. Accordingly, as discussed above and in the attached Declaration, Example 3 is commensurate in scope with Claim 1. Further, Comparative Example 3 corresponds to Claim 1, with the exception of the extensibility discussed above. Accordingly, the Table clearly shows that it is the extensibility, and not any other material, load, method of preparing, etc. that produces the unexpected results.

The Response to Arguments section points out that “Examples 1 and 2 are not discussed in the declaration neither are comparative examples 1 and 2.” Since Example 3 and Comparative Example 3 clearly demonstrate the unexpected results, it is not necessary to discuss the other examples.

The Response to Arguments section also states that “the test should show the results of the test performed on the invention as claimed and the closest prior art.” However, Applicants respectfully submit that the point of the Declaration is to show the unexpected result of having a relative extensibility of at least 15 versus a relative extensibility of less than 15. Kobayashi does not recite a specific relative extensibility. Thus, a test with a specific relative extensibility according to Kobayashi cannot be performed and is not necessary to show the unexpected results.

Specifically, as explained in paragraph [0132] of Kobayashi, a hair holder comprised of the sheet 223A which has longitudinal extensibility and the sheet 223B which has substantially no longitudinal extensibility “can be rolled up smoothly, with which ever of the sheets 223A and 223B inside, to curl hair easily, surely, and neatly.” Therefore, Kobayashi does not recognize that, below a certain relative extensibility of the first and second sheets, the hair holder **will not** curl hair easily, surely, and neatly.

Thus, Applicants respectfully submit that the relative extensibility of at least 15 between the first and second sides of the hair holder is an unexpected result not shown by Kobayashi.

Claim 1 also recites that “the extensibility of the sheet which forms the first side is 10% or higher under the load of 5 N.” Paragraph [0132] of Kobayashi merely recites that the sheet 223A “has longitudinal extensibility,” but does not recite that this extensibility is at least 10% under a 5 N load. Further, the first side sheet 223A of Kobayashi can have an extensibility outside of the claimed range, and still work for its intended purpose, as noted above. Therefore, Kobayashi does not teach that the sheet 223A has the claimed extensibility.

Accordingly, it is respectfully submitted that Kobayashi does not disclose or suggest every feature recited in Claim 1. Thus, it is respectfully requested that the rejection of Claim 1, and all claims dependent thereon, as unpatentable over Kobayashi be withdrawn.

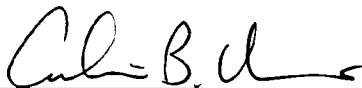
Independent Claim 8 recites, *inter alia*, a method of treating hair, including employing a hair holder in which “the sheet which forms the second side of the tube has a Taber stiffness of 0.4 mNm or higher, and the sheet which forms the first side has an extensibility of at least 15 times an extensibility of the sheet which forms the second side under a load of 5 N, the extensibility of the sheet which forms the first side is 10% or higher under the load of 5 N, and the extensibility of the sheet which forms the second side is 5% or less under the load of 5 N ... and rolling up the tube having the hair therein with the first side thereof facing out.”

Therefore, in view of the discussion of Kobayashi with respect to Claim 1, it is respectfully submitted that Kobayashi does not disclose or suggest every feature recited in Claim 8. Thus, it is respectfully requested that the rejection of Claim 8, and all claims dependent thereon, as unpatentable over Kobayashi be withdrawn.

Consequently, in view of the present amendment, no further issues are believed to be outstanding in the present application, and the present application is believed to be in condition for formal allowance. A Notice of Allowance is earnestly solicited.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, L.L.P.



Richard L. Chinn
Attorney of Record
Registration No. 34,305

Customer Number
22850

Tel: (703) 413-3000
Fax: (703) 413 -2220
(OSMMN 07/09)

Colin B. Harris
Registration No. 58,969